

REMARKS

This response is intended as a full and complete response to the final Office Action mailed May 17, 2007 and the Advisory Action mailed on July 30, 2007. In the Office Action, the Examiner notes that claims 1, 3-9, 14, 18, 19, 23, 24, 28-32, 34, 37, 40-43, 45-50, 52, 53 and 55-64 are pending and rejected. However, the Applicants submit that it appears that the Examiner inadvertently left out claim 54, which the Applicants believe is also still pending.

In view of the following discussion, Applicants submit that all of the claims pending in the application are patentable under 35 U.S.C. §§112 and 103.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

The Applicants herein submit a declaration under 37 C.F.R. § 1.132 as a submission in connection with the present request for continued examination under 37 C.F.R. 1.114 to overcome the rejections under 35 U.S.C. § 112 as discussed below.

REJECTIONS

I. REJECTION OF CLAIMS 1, 3-9, 14, 18, 19, 23, 24, 28, 29, 42, 43, 45-50, 52, 53, 55, 56, AND 58-64 UNDER 35 U.S.C. § 112

The Examiner has rejected claims 1, 3-9, 14, 18, 19, 23, 24, 28, 29, 42, 43, 45-50, 52, 53, 55, 56, and 58-64 under 35 U.S.C. §112, ¶1, as failing to comply with the enablement requirement. The Applicants note that it appears that the Examiner has inadvertently failed to include pending claim 54. Therefore, the Applicants assume that the Examiner meant to include claim 54 within this rejection and will proceed as such. Regardless, the rejection is traversed.

Under 35 U.S.C. §112, paragraph 1, the applicant is required to satisfy the written description and enablement requirements. The relevant portion of the statute requires that "the specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact

terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.”

Moreover, the courts have interpreted 35 U.S.C. § 112 such that the specification and claims may not be rejected for lack of written description under 35 U.S.C. §112, first paragraph, when details in the claims that are not described in the specification are within the level of ordinary skill in the art. *In re Skrivan*, 427 F.2d 801, 166 USPQ 85, 88 (C.C.P.A. 1970). Notably, the written description and enablement requirement generally requires the applicant to describe the invention to one of ordinary skill in the art. The Court has held that “[n]ot every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be.” *In re Gay*, 309 F.2d 769, 135 USPQ 311, 316 (C.C.P.A. 1962).

The Applicants respectfully submit that the specification enables one of ordinary skill in the art. For example, the Applicants’ specification teaches that the expansion card or hardware upgrade may be inserted into an expansion card slot 665 causing the connector on the expansion card to electrically link with a card connector on the set top terminal 220. (See e.g., Applicants’ specification, p. 37, ll. 13-16.) As stated under case law, the Applicants’ are not required to describe every last detail. The Applicants’ respectfully submit that one skilled in the art would know what type of connection to use to “electrically link” the expansion card or hardware upgrade to a card connector.

To further support the Applicants’ position that one of ordinary skilled in the art would know how to manufacture an insertable upgrade card having a modem based upon the Applicants’ specification, the Applicants herein submit a declaration of Bruce Bahlmann under 37 C.F.R. § 1.132. Therefore, the Applicants respectfully submit that the claims fully satisfy the requirements of 35 U.S.C. § 112, first paragraph and respectfully request the rejection should be withdrawn.

II. REJECTION OF CLAIMS 30-32, 34, 37, 40-41, 45-50, 55, 56 AND 58-59 UNDER 35 U.S.C. § 103

The Examiner has rejected claims 30-32, 34, 37, 40-41, 45-50, 55, 56 and 58-59 as being obvious under 35 U.S.C. §103 over Palazzi (U.S. Patent 5,327,554) in view of

Banker (U.S. Patent 5,357,276) and Florin (U.S. Patent 5,583,560). Applicants respectfully traverse the rejection.

The Applicants respectfully submit that a *prima facie* case of obviousness has not been established because Palazzi and Banker fail to teach or suggest the Applicants' invention and Florin is not a proper reference against the Applicants' invention. Notably, the Examiner admits that Palazzi and Banker fail to teach the Applicants' invention in its entirety and relies on Florin to bridge the substantial gap left by Palazzi and Banker.

However, the Applicants respectfully submit that Florin is not prior art with respect to the Applicants' invention. Although the present invention is a continuation-in-part application, those claims that are fully supported by the parent application benefit from the earlier filing date of the parent application. Florin has a priority date of June 22, 1993. The parent application of the present invention has a filing date of December 9, 1992.

All the features of the present independent claims 30 and 42 are fully disclosed in the parent application. Specifically, the parent application discloses a television terminal having a modem 627, wherein the hardware upgrade is on a card 700 and the upgrade includes 4 possible hardware upgrades such as Level B interactive unit as disclosed on pages 54-55. The upgrade utilizes the modem of the television terminal. This is also shown in FIG. 7b, which shows the hardware upgrade for generating the desired menus with on-line information.

The Examiner responds by stating that the parent application does not support the current claims, specifically pointing to claims 30 and 42 as examples. The Applicants respectfully submit that the parent application filed on December 9, 1992 (hereinafter "parent application") clearly teaches that the modem communicates with the interactive service and an on-line database, wherein the interactive service and the on-line database are outside of the television program system as recited in claim 30. For example, on page 109, lines 15-17, the specification teaches that the Level B interactive services (accessed with the level B hardware upgrade inserted into the set top terminal) include access to a variety of on-line type services such as Prodigy, Yellow Pages, Airline Reservations, etc. Notably, Prodigy is at least one example of an

interactive service or on-line database that is outside of the television program system.

In addition, the Applicants respectfully submit that the parent application also clearly teaches a hardware upgrade inserted into the set top terminal. The Applicants agree that an exemplary embodiment teaches that the hardware upgrade is connected via an upgrade port 662. (See e.g., parent application, p. 54, ll. 1-3; FIG. 8b).

However, the parent application also teaches an expansion card slot or expansion slot 664 for upgrading the terminal hardware. (See e.g., parent application p. 53, ll. 15-22; FIG. 8b.) One skilled in the art would know that the expansion card slot 664 may also be used for inserting a hardware upgrade, as evidenced by the declaration under 37 C.F.R. § 1.114 submitted herewith.

In addition, the Applicants believe that all remaining claims are also fully supported by the parent application. Therefore, the Applicants' respectfully submit that the present application is accorded the priority date of the parent application filed on December 9, 1992. Therefore, the Applicants respectfully submit that Granger and Florin are not prior art with respect to the Applicants' application.

As such, Applicants submit that claims 30 and 42 are not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Claims 31-32, 34, 37, 40-41, 45-50, 55, 56 and 58-59 depend, either directly or indirectly, from independent claims 30 and 42 and recite additional features thereof. As such, and for at least the same reasons discussed above, Applicants submit that these dependent claims also fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the rejection should be withdrawn.

CONCLUSION

Applicants believe all the claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the issuance of an adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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